

remarks.

On the cover page of the Office Action, the box relating to finality of the Office Action is crossed. However, the body of the Office Action makes no mention of the finality, and thus the Office Action is (at least technically) not properly final. Additionally, the new rejection of claim 12 under 35 USC 102(b) was not necessitated by Applicants' earlier amendment, since this amendment was of a formal nature only, specifically to incorporate the text of the unelected claim 11 into claim 12. Therefore, Applicants respectfully ask that the finality of the Office Action be withdrawn.

The rejection of claims 1 - 8 and 15 - 17 was maintained under 35 USC 102(e) over Kausch et al. The Examiner stated in part that "the chromosomal DNA inherently comprises the DNA claimed and thus anticipates the claims" and that "Kausch et al. anticipates the claims as discussed above because the chromosomal DNA is disclosed." The Examiner then stated:

"Applicants argue that Kausch et al. [t]eaching in Example 2 concerns the isolation and sorting of human chromosome 1 which does not comprise the DNA encoding ER-beta which is located on chromosome 14. However, the Kausch et al. teaches that many chromosomes can be sorted at once (column 9, lines 29 - 43), which includes all the chromosomes in the cell."

This rejection is respectfully traversed.

Aside from the question of whether a disclosure of an isolated chromosome anticipates a claim to a particular isolated DNA, which is located on the disclosed chromosome (which Applicants believe does not constitute an anticipation), in the present case, Kausch et al. does not disclose an isolated chromosome 14. Thus, the above anticipation issue is not relevant.

As already indicated by Applicants in their previous response, Kausch et al. relates to a method for the isolation and sorting of biological material such as chromosomes and/or segments of chromosomes. The method is considered as an alternative to flow cytometry. Kausch et al. disclose that this sorting method can be used to obtain large amounts of pure chromosomes for various purposes, including library construction and cloning. Kausch et al. also suggest that the sorted material can be used to transform host cells or vectors. However, this is only a generic teaching. Kausch et al. differ from the present invention in that they disclose a method for the isolation and sorting of chromosomes in general and are not concerned with isolated DNA *per se*. In contrast, the present invention is directed to a particular isolated DNA and its use in medical research. In summary, Kausch et al. is nothing more than a general teaching about hypothetical uses of a method and does not teach or suggest the claimed invention.

Therefore, the Kausch et al. reference is not an anticipatory reference, and Applicants thus ask that the 35 USC 102(e) rejection be withdrawn.

Claim 12 was newly rejected under 35 USC 102(b) as anticipated by Evans et al. This rejection is traversed by the above amendment of claim 12. The latter amendment of claim 12 was made only to correct claim form. Accordingly, Applicants ask that this rejection also be withdrawn.

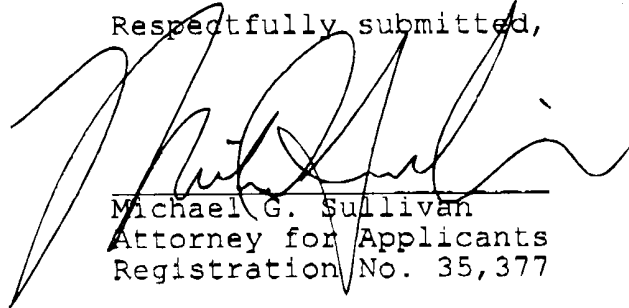
In view of the remarks above, with the present amendments, it is believed that this application is in condition for allowance. Favorable action is solicited.

Should the Examiner consider that a conference would be

helpful in advancing the prosecution of this application, he is invited to contact the undersigned at the number below.

In the event any fees are required with this paper, please charge our Deposit Account No. 02-2334.

Respectfully submitted,



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